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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,465	02/25/2004	Lee Bolduc	9494.18514	9327
26308 7590 03/26/2010 RYAN KROMHOLZ & MANION, S.C. POST OFFICE BOX 26618 MILWAUKEE, WI 53226				
EXAMINER				
RYCKMAN, MELISSA K				
ART UNIT		PAPER NUMBER		
3773				
MAIL DATE		DELIVERY MODE		
03/26/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/786,465

**Applicant(s)**

BOLDUC ET AL.

**Examiner**

MELISSA RYCKMAN

**Art Unit**

3773

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 7/22/09.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 32-39 and 44 is/are pending in the application.
- 4a) Of the above claim(s) 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-36,38,39 and 44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/22/09 has been entered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 32- 36,38,39 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahmed (U.S. Patent No. 5,320,630), and further in view of Parodi et al. (U.S. Patent No. 6,592,593).

Claim 32:

Ahmed teaches a motor-driven tool for applying an implantation force to a fastener sized and configured for implantation in tissue in response to an implantation force applied according to prescribed conditions, the motor-driven tool comprising a tool body (entire apparatus as seen in Fig. 10), a driven motor (72) carried in the tool body, a driven member (52, Fig. 3) coupled to the drive motor, the driven member being

carried by the tool body and being operable to apply the implantation force (Fig. 3) during operation of the drive motor, a carrier (40) on the driven member (52) to couple the fastener to the driven member to transfer the implantation force from the driven member to the fastener (Fig. 3), a motor control unit (74) carried in the tool body (entire apparatus of Fig. 10) and being coupled to the drive motor (Fig. 10), the motor control unit being conditioned to operate the drive motor in phases (col. 9, ll. 33-35) including an initial phase operating the carrier to transfer the implantation force to the fastener (Fig. 3) under conditions than are short of the prescribed conditions so that the fastener remains coupled to the carrier, a lull phase commencing automatically (this is inherent) at the end of the initial phase interrupting operation of the carrier, and a final phase operating the carrier under conditions that supplement the conditions of the initial phase to achieve the prescribed conditions to release the fastener from the carrier and implant the fastener in tissue (Figs. 8 and 9), the motor control unit requiring, after automatically entering the lull phase, a prescribed final phase command to advance from the lull phase to the final phase (the phases occur as described during certain surgeries col. 7, ll. 32-35).

Ahmed teaches the claimed invention but does not teach a helical fastener sized and configured for penetration, however Parodi teaches a helical fastener (Fig. 5 and 26) that can be partially implanted. It would have been obvious to one of ordinary skill in the art to use the helical fastener of Parodi as this aids in securing the fastener into the tissue.

Claims 33 and 34:

Ahmed teaches the prescribed command is based on input from an operator and upon input reflecting a sensed operating condition (col. 7, ll. 32-35).

Claim 35:

Ahmed teaches the driven member is also operable to apply a removal force to withdraw the fastener from tissue (Fig. 7, when rotating the fastener in place the fastener can be rotated the opposite way so the fastener will not be successfully placed), and wherein the motor control unit includes a removal phase operating the carrier (col. 7, ll. 32-35) to transfer the removal force (Fig. 7) to the fastener, the motor control unit requiring, after automatically entering the lull phase, a prescribed removal phase command different than the prescribed final phase command to advance from the lull phase to the removal phase.

Claim 36:

Ahmed teaches the driven member is rotated in one direction to transfer the implantation force (Fig. 3) and rotated in an opposite direction to apply the removal force (Fig. 3).

Claims 38 and 39:

Ahmed teaches the tool body includes a tube (27) that carries the driven member and the carrier (Fig. 3) and the driven member is rotated (Fig. 3) to apply the implantation force.

Claim 44:

Ahmed teaches coupling a fastener to the driven member, accessing a tissue region, operating the motor-driven member during the initial phase to partially implant

the fastener in the tissue region (col. 7, ll. 32-35 and col. 9, ll. 33-35), deciding during the lull phase to commence the final phase, entering the prescribed command to advance from the lull phase to the final phase (col. 4, ll. 62), thereby completing the implantation of the fastener in the tissue region.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA RYCKMAN whose telephone number is (571)272-9969. The examiner can normally be reached on Monday thru Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571)-272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MKR  
/Melissa Ryckman/  
Examiner, Art Unit 3773

/(Jackie) Tan-Uyen T. Ho/  
Supervisory Patent Examiner, Art Unit 3773